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10/826,501	04/19/2004	Susumu Aoyama	040075	1350

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EXAMINER	
WHIPKEY, JASON T	

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2622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Application No.	Applicant(s)
10/826,501	AOYAMA ET AL.
Examiner	**Art Unit**
Jason T. Whipkey	2622

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed November 27, 2007, have been fully considered but they are not persuasive.

Applicant argues that claims 13 and 14 were incorrectly rejected under 35 U.S.C. § 101. The examiner disagrees.

Applicant cites *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998), arguing that this decision "suggested that almost any unobvious software-related invention is patentable if the claims are properly drawn" (emphasis original). However, in the *State Street* case, "claim 1 is directed to a machine programmed with the Hub and Spoke software and admittedly produces a 'useful, concrete, and tangible result.' ... This renders it statutory subject matter, even if the useful result is expressed in numbers, such as price, profit, percentage, cost, or loss." *Id.* at 1602.

In the instant case, claims 13 and 14 are not drawn to a machine programmed with software. Instead, they are drawn to "[a] photographing control program" (emphasis added).

Computer programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional

interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized and is thus statutory. See *In re Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Regarding the independent claims, Applicant argues that the Ohnuki reference fails to disclose shifting the optical system to a fixed focus position. The examiner agrees. However, as noted in the previous rejection, this feature is in the Hamamura reference. Specifically, Hamamura discloses a camera that relocates the focusing lens to a predetermined position when the focusing lens is unable to reach a desired focal position (see column 20, lines 11-15). An advantage of driving a focus lens to a fixed, central point is that the chances of an image being in focus are maximized.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Objections

2. The amendment to the claims is approved and the corresponding objection is withdrawn.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13 and 14 define a "program" embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory. That is, the scope of the presently claimed program can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 3, 4, 6-8, 10, and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuki (U.S. Patent No. 4,969,003) in view of Hamamura (U.S. Patent No. 5,815,748).

Regarding **claims 1, 6, 10, and 12**, Ohnuki discloses an electronic device having an optical system (see Figure 2) for capturing an image comprising:

a focusing mechanism (lens motor LMTR) for moving said optical system to an auto-focusing position (see column 9, lines 52-66), comprising:

a switch (a release button that is not shown) that functions as a focusing switch (switch SW1; see column 9, lines 1-11) and also functions as a shutter switch (switch SW2; see column 9, lines 4-11), wherein said switch when operated orders a focusing action or orders capturing of the image; and

a controller (control device PRS) that, in the case where a shutter operation of said switch is performed during a focusing action of said focusing mechanism due to said switch, shifts said optical system to a fixed focus from an auto-focusing position and takes a fixed focus image (the focusing is stopped and the image is captured; see column 18, lines 54-59).

Ohnuki is silent with regard to *moving* the lens to a fixed focus position.

Hamamura discloses a camera with a lens. When the focus lens is unable to reach a desired focal position, the lens is driven to the middle of its focal point range (see column 20, lines 11-15).

An advantage of driving a focus lens to a fixed, central point is that the chances of an image being in focus are maximized when an original focus cannot be achieved. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Ohnuki's system drive its focus lens to a middle point, as described by Hamamura.

Regarding **claim 2**, Ohnuki discloses:

> said controller compares between a time required for bringing into focus in said focusing mechanism and a time from starting of the focusing action until starting of said shutter operation (release time lag TR; see column 19, line 67, through column 20, line 25), and changes said optical system to said auto-focusing position or said fixed focus position based on a result of the comparison (see column 22, lines 20-29).

Regarding **claims 3 and 7**, Ohnuki discloses:

> said switch is provided as a first switch (SW1; see column 9, lines 1-11), and a switch which is used in photographing by a fixed focus is also provided as a second switch separated from the first switch (SW2; see column 9, lines 4-11).

Regarding **claims 4 and 8**, Ohnuki discloses:

> said switch functions as said focusing switch at a state of a half-push and functions as said shutter switch at a state of a full-push (see column 9, lines 1-11).

Claims 13 and 14 can be treated like claim 1. Additionally, Ohnuki discloses that control device PRS stores a program that is executed to control the camera (see column 7, lines 59-67).

Claims 15 and 16 can be treated like claim 1. Additionally, Ohnuki discloses an integrated circuit (control device PRS is a single-chip microcomputer; see column 7, lines 59-67).

8. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuki in view of Hamamura and further in view of Terasaki (U.S. Patent No. 7,119,843)

Claims 5 and 9 can be treated like claims 1 and 6, respectively. However, Hamamura is silent with regard to the device having two housing parts that fold up.

Terasaki discloses an imaging device, including:

a first housing part (arm 6 in Figure 5) that has said imaging part (imaging optical system 4);

a second housing part (phone body 1) that has said switch (shutter button 12; see column 5, lines 8-13); and

a coupling part (hinge 5) that couples said first housing part and said second housing part so that the first and second housing parts can be folded up (see column 4, lines 19-29).

An advantage of using two housing parts that fold up is that the device can be carried compactly. For this reason, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to have Hamamura's system include two housing parts that fold up, as described by Terasaki.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohnuki in view of Hamamura and further in view of Iida (U.S. Patent No. 5,001,507).

Claim 11 can be treated like claim 10. However, Hamamura is silent with regard to superimposing a focusing mark on an image display.

Iida discloses an imaging device, including:

> a process that superimposes a focusing mark (42 and 43 in Figure 10) representative of a distance between a pictured object and the optical system on an image, in the middle of said focusing action, which is caught by said imaging part, and displays it (on a viewfinder; see column 13, lines 47-61).

An advantage of superimposing a focusing mark on a pictured object is that a user can have more information when composing an image, thus resulting in an improved output. For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have Hamamura's system include a focusing mark on an image display.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 6 P.M. eastern standard time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye, can be reached at (571) 272-7372. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTW
JTW
February 5, 2008

LIN YE
SUPERVISORY PATENT EXAMINER